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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,276	05/09/2002	Gavin Randall Tame	P-6396	9013

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EXAMINER

HENEGHAN, MATTHEW E

ART UNIT PAPER NUMBER

2134

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/030,276	Applicant(s) TAME, GAVIN RANDALL	
	Examiner Matthew Heneghan	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 6-15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 14 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-18 have been examined.

#### ***Priority***

2. The instant application in the national stage entry of International Application PCT/IB00/00908, filed 5 July 2000.
3. The instant application claims priority to South Africa Patent Application No. 99/4367, filed 5 July 1999.

#### ***Claim Objections***

4. Claims 6-15 are objected to under 37 CFR 1.75(c) as being in improper form because multiple dependent claim 6 is dependent upon multiple dependent claim 4, and claims 7-15 are all dependent at least upon claim 6. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, the phrase "or another biometric device" renders the claim indefinite because the claim includes elements not actually disclosed (those encompassed by "or another biometric device"), thereby rendering the scope of the claim unascertainable. For purposes of the prior art search, it is being presumed that the claim teaches to any variety of biometric input.

Claim 4 depends from rejected claim 3, and includes all the limitations of that claim, thereby rendering that dependent claim indefinite.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,157,726 to Merkle et al.

Merkle discloses a system for authenticating a document wherein the system is available to a user having a smart card establishing the user's identity (see column 4, lines 47-59), and data identifying the user is read from the smart card (see column 4, lines 52-62). Document data is generated from an inputted document (digitization) (see column 4, lines 24-46). A signature (verification data) is generated using the digitized document and user information (see column 4, lines 40-46). The digital signature is affixed to the outputted document (see column 4, lines 63-66). Since the printed signed document is then read by another receiving machine, it must be machine-readable (see column 6, lines 52-58).

7. Claims 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,671,282 to Wolff et al.

As per claim 16, Wolff discloses a system wherein a document is create based upon inputted data for the document along with a identifier for the author, and data for verification is written to the document in machine-readable form. An electronic copy is saved on a server subsystem (see column 7, lines 24-29).

As per claims 17 and 18, the document is then read by a client subsystem with retrieves the corresponding information from the server and compares it with the information on the document (see column 7, lines 33-43).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,157,726 to Merkle et al. as applied to claim 1 above, and further in view of U.S. Patent No. 5,341,428 to Schatz.

Though Merkle discloses the use of smart cards containing user data for entering the system, Merkle does not specifically suggest the comparison of the user identification record with user data.

Schatz discloses the storing of a PIN or biometric data within a smart card being used for authentication that must be matched to inputted data at the time of use (see column 3, lines 30-45 and column 4, lines 20-33), and suggests that this leads to a more fool-proof verification system (see column 2, lines 3-22).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of Merkle by using biometric data from a smart card at the time of use, as disclosed by Schatz, as this leads to a more fool-proof verification system.

### ***Conclusion***

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached at (571) 272-3838.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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November 22, 2005

*Gy OM*  
GREGORY MORSE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2134